

REMARKS**Status of Claims**

The Office Action mailed May 23, 2005, has been reviewed and the Examiner's comments have been carefully considered. Claims 1-28 were pending in the application, with claims 4, 13-16 and 19-22 withdrawn from consideration. Claim 1 has been amended, claim 28 has been cancelled, and claim 29 has been added. Therefore, claims 1-27 and 29 are pending with claims 1-3, 5-12, 17, 18, 23-27, and 29 being submitted for reconsideration.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier.

Section 112, Second Paragraph, Rejection

Claims 1-3, 5-12, 17, 18, and 23-28 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants submit that the pending claims are in definite form and meet the requirements of 35 U.S.C. § 112, second paragraph.

Specifically, applicants note that the pending independent claim 1 has only been amended to include subject matter from claim 28, and to improve its readability and not to change its scope in any way from the previously pending claim 28. Applicants submit that the indefiniteness rejection of the previously pending claims was not appropriate for the following reasons.

First, the previously pending independent claim 1 recited a logical relationship in the form of “if *predicate* then *relationship*” in which the *predicate* defined the *variables* used in the *relationship*. Such definition of logical relationships is well known to those of ordinary skill in the art, i.e. high school students are familiar with logical relationships defined in this form, and the person of ordinary skill in the art for the instant invention has at least a high school level of education (and more likely an engineering degree or equivalent experience). The Office Action's assertion that the use of “if” renders the claim indefinite is erroneous since the claims are interpreted from the perspective of one skilled in the art, and the previously pending claims were definite to one skilled in the art. As stated in MPEP §2173.02, in reviewing a claim for compliance with 35 U.S.C. §112 second paragraph, “the

examiner must consider the claim as a whole to determine whether the claim apprises *one of ordinary skill in the art* of its scope and, therefore, serves the notice function required by 35 U.S.C. §112 second paragraph.” (Emphasis added).

Second, with respect to claim 28, the Office Action speculates on a hypothetical that completely vitiates an explicit recitation in the claim. Specifically, the Office Action speculates that “if n is equal to 2” when claim 1 (from which claim 28 depends) explicitly recites that the shield plate is formed with at least four cutouts (i.e., $n \geq 4$). Accordingly, any assertion of indefiniteness based on a speculation that ignores specific language in a claim is improper and should be withdrawn. Furthermore, the claimed relationships are consistent with each other and are intended to be used together, as claim 28 depended from claim 1. Therefore, applicant submits that the pending claims were and are in definite form. Accordingly, this rejection should be withdrawn.

Prior Art Rejections

Claims 1-3, 5-8, 17, 18, and 23-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,597,030 to Hallerback (hereafter “Hallerback ‘030”) in view of U.S. Patent No. 3,854,734 to West (hereafter “West ‘734”). Claims 9-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hallerback ‘030 in view of West ‘734 as applied to claims 1-3, 5-8, 17, 18, and 23-28 above, and further in view of U.S. Patent 4,339,565 to Tomoda (hereafter “Tomoda”). Applicants respectfully traverse these rejections for at least the following reasons.

The features recited in the pending independent claim 1 are not disclosed or suggested by the applied prior art. Specifically, the Office Action acknowledges (in the discussion of claim 28) that the specific recited relationships are not disclosed in the applied prior art. Rather, the Office Action asserts that “wherein a n less than or equal to 2Z is possible and therefore inherently incorporated by Hallerbeck ‘030.” This conclusion is erroneous because inherency cannot be established by a mere possibility. The standard for inherency requires that the feature be *necessarily present* in the prior art and not simply that it may occur or be present, i.e., be broadly included in a general or non-specific prior art teaching. See MPEP 2112 and the cases cited therein including *In Re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir.

1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82 (CCPA 1981) (to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill).

As noted earlier, with respect to obviousness, an allegation that claimed subject matter is “obvious” (as here alleged) requires a positive, concrete teaching in the prior art, such as would lead a person skilled in the art to choose the claimed combination from among many that might be comprehended by broad prior art teachings. The PTO’s review court has made it very clear that silence in a reference is hardly a substitute for clear and concrete evidence from which a conclusion of obviousness might justifiably flow. See, e.g., *Application of Burt*, 356 F.2d 115, 121 (CCPA 1966). There is no such positive or concrete teaching of the claimed relationships in the applied prior art that would render claim 1 obvious.

As noted in the specification, the recited features provide the advantage that non-repetitive runout is prevented from occurring during operation of the rolling bearing with the shield plate, even though the installation of the shield plate may cause minute deformations on the outer ring. See page 14, lines 4-8 of the specification. Therefore, neither the specifically claimed features nor their advantages are disclosed or suggested by the applied prior art.* Accordingly, the applied rejection should be withdrawn.

The dependent claims are also in condition for allowance for at least the same reasons, as discussed above, as the independent claims on which they ultimately depend. In addition, they recite additional patentable features when considered as a whole.

For example, newly formulated claim 29 recites a shape of the outer peripheral edge portion of the shield plate, i.e., the outer peripheral edge portion of the shield plate has a substantially semi-circular shape in cross section which is anchored in the anchor groove on the inner peripheral surface of the outer ring.

In a shield plate wherein the outer peripheral edge portion has a substantially semi-circular shape in cross section, this outer peripheral edge portion is engaged with the opening

* In this context it should be noted that claims similar to the pending claims were recently issued by the Japanese Patent Office.

portion on the radially inner side of the anchor groove, through a plastic deformation to make its diameter larger (crimping it wider). This structure has a significant impact on the occurrence of non-repetitive run-out, and therefore a significant advantage is achieved by controlling the number "n" of the cutouts and the number "Z" of the rolling member appropriately, as recited in the claim.

On the other hand, with the structure of Hallerbeck '030 (which is similar to the structure in Fig. 5 and 6 of the present application), the outer peripheral edge portion having an elastic sloping portion engages the anchor with a snap. This structure has less impact on occurrence of non-repetitive run-out. West '734 does not disclose any shield plate having cutouts. Accordingly, the features recited in claim 28 are not disclosed or suggested by the applied prior art, a fact that provides an additional reason for the patentability of claim 29.

Conclusion

In view of the foregoing amendments and remarks, applicant submits that the application is now in condition for allowance. If there are any questions regarding the application, or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is courteously invited to contact the undersigned attorney at the local telephone number below.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicants hereby petition for any needed extension of time.

Respectfully submitted,

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FOLEY & LARDNER LLP

Customer Number: 22428

Telephone: (202) 672-5485

Facsimile: (202) 672-5399

By Aaron C. Chatterjee

Richard L. Schwaab

Registration No. 25,479

Aaron C. Chatterjee

Registration No. 41,398

Attorneys for Applicants